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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,683	03/04/2002	Kurt Schwarzwaldner	63,799-036	8852

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DYKEMA GOSSETT PLLC
39577 WOODWARD AVENUE
SUITE 300
BLOOMFIELD HILLS, MI 48304-5086

EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

669

Office Action Summary

Application No.

10/090,683

Applicant(s)

SCHWARZWALDER ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/5/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 13,17-18,20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bentley et al. (5472228).

Bentley et al. discloses a polymeric component comprising a primary extrusion (figure 3 number 44a), a section molded portion integral with the primary extrusion (figure 3 number 52 and 44a), and wherein the section molded portion is formed as a projection having a cross section with variable dimensions including a first portion (figure 3 number 53a) and a second portion extending from the first portion (figure 3 number 52b) and having a second outer dimension that is greater than the first outer dimension of the projection (figure 3 number 52b). Bentley et al. discloses at least one section molded portion formed in the portion of the primary extrusion (figure 3 number 44a and 52) formed from thermoplastic material (col. 3 lines 5-6) and extending from the primary extrusion (figure 3 number 44a) and integral with the primary extrusion (figure 3 number 44a), the section molded portion capable of interconnection with an aperture (figure 4 number 54) in a portion of a mating structure and having suitable rigidity (figure 4) to retain the primary extrusion relative to the structure (figure 4). Bentley et al.

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discloses that the section molded portion being in the shape of a barbed projection (figure 3 number 52) having a thin walled portion having a first outer diameter (figure 3 number 52) and extending from the primary extrusion (figure 3 number 44a) and a thick wall portion having a second outer diameter greater than the first outer diameter (figure 3 number 53). Bentley et al. discloses that the primary extrusion being formed from a C-shaped cross section in which a portion of the cross section is formed from thermoplastic material (figure 4 number 44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bentley et al. (5472228).

Bentley et al. discloses that the primary extrusion being formed at least in part by thermoplastic material (col. 3 lines 5-6). Bentley et al. discloses that the primary extrusion is being formed from two layers attached to each other (figure 4 number 44 and 46), each layer formed of thermoplastic material (col. 4 lines 5-6). Bentley et al. fail to disclose that the thermoplastic is selected from polypropylene, talc filled polypropylene, polyethylene, soft TPE, rigid TPE, nylon, and ABS/PVC. Bentley et al. fail to disclose that the primary extrusion being formed from a layered coextrusion.

It would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Bentley et al. with the thermoplastic is selected from polypropylene, talc filled polypropylene, polyethylene, soft TPE, rigid TPE, nylon, and ABS/PVC, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. In re Leshin, 125 USPQ 416.

Since applicant's primary extrusion is formed from two layers attached to each other, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide the primary extrusion being formed from a layered coextrusion for the purpose of providing a stronger primary extrusion since coextrusion is a type of integral molding that provides a more secure and stronger attachment of two layers than two layers being attached by a separate attachment means.

3. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bentley et al. in view of Kojima (4427328).

Bentley discloses the polymeric component described above. Bentley fail to disclose that the section-molded portion has a corrugated inner shape and corrugated outer shape. Kojima teaches that the section-molded portion has a corrugated inner shape and corrugated outer shape (figure 1 number 8) for the purpose of providing the insertion of the fastener into the fitting hole with slight force and the extraction of the fastener from the fitting hole is obtained with great force (col. 4 lines 39-46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Bentley with the section-molded portion that has a corrugated inner shape and corrugated outer shape in order to provide the insertion of the fastener into the fitting hole with slight force and the extraction of the fastener from the fitting hole is obtained with great force (col. 4 lines 39-46) as taught by Kojima.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation forming the section molded portion by zone heating a portion of the primary

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extrusion to create a molten zone and compressing the portion having the molten zone in a die cavity until the section molded portion takes the shape of the die cavity and forms a solid state, or by heating a polymeric compound and forcing the heating compound through an orifice to form a heated extrusion, and cooling the heated extrusion to form the primary extrusion in a solid state, or compressing the molded portion into the die cavity by a pressing unit having a corrugated shape and the die cavity having a shape corresponding to a corrugated shape is a method of production and therefore does not determine the patentability of the product itself.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. The preliminary amendment filed on April 25, 2002, has been acknowledged by the Examiner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee
November 7, 2003



WILLIAM P. WATKINS III
PRIMARY EXAMINER